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EXAMINER

LEWIS, RALPH A

ART UNIT

PAPER NUMBER

3732

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,992

Applicant(s)

CAO, DENSEN

al

Examiner

Ralph A. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-9, 12-20 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Rejections based on 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 20, line 1, "annual well"?

Double Patenting Rejections

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 19 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 20 of copending Application No. 10/017,272. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 19 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 23 of copending Application No. 10/017,455. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Rejections based on Obvious-type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17, 19 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,331,111 in view of Mills (WO 99/16136). The patented claims of 6,331,111 set forth all the limitations of the present claims with the exception of those requiring the secondary heat sink to be elongated. Mills, however, teaches that it is

desirable to provide for an elongated secondary heat sink 45, 50, 51, in order to draw heat away from the primary heat sink 48. To elongate the secondary heat sink set forth in the patented claims of 6,331,111 in order to better draw heat away from the primary heat sink as taught by Mills would have been obvious to one of ordinary skill in the art.

Claims 1-18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/017,272 in view of Prinsze (US 4,092,580). The claims of copending application 10/017,272 set forth all the limitations of the present claims with the exception of those relating to the wall outlet AC/DC power adapter. Wall outlet AC to DC adapters for recharging light batteries is old and well known as taught for example by Pinsze who uses wall AC to DC adapter 37 for charging light batteries 84, 85, 86. Merely adding a prior art conventional AC/DC power adapter to the claimed 10/017,272 apparatus so that the battery power source may be recharged would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1- 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/017,454 in view of Prinsze (US 4,092,580). The claims of copending application 10/017,454 set forth all the limitations of the present claims with the exception of those relating to the wall outlet AC/DC power adapter. Wall outlet AC

to DC adapters for recharging light batteries is old and well known as taught for example by Pinsze who uses wall AC to DC adapter 37 for charging light batteries 84, 85, 86. Merely adding a prior art conventional AC/DC power adapter to the claimed 10/017,454 apparatus so that the battery power source may be recharged would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/017,455 in view of Prinsze (US 4,092,580). The claims of copending application 10/017,455 set forth all the limitations of the present claims with the exception of those relating to the wall outlet AC/DC power adapter. Wall outlet AC to DC adapters for recharging light batteries is old and well known as taught for example by Pinsze who uses wall AC to DC adapter 37 for charging light batteries 84, 85, 86. Merely adding a prior art conventional AC/DC power adapter to the claimed 10/017,455 apparatus so that the battery power source may be recharged would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Mills (WO 99/16136).

Mills discloses a dental curing light (page 1, second paragraph) comprised of a hand held wand (Figure 5) having a light module 47, an elongated heat sink 45, 50, 51, having a distal end surface serving as a mounting platform on which primary heat sink 48 is mounted and light emitting semiconductors 43 mounted to the primary heat sink 48. In regard to the "controls" and "circuitry" limitations of claim 17, it is an inherent necessity that the Mills device include an on/off switch.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (WO 99/16136)

Mills does not explicitly appear to state that the disclosed dental photo curing device has an on/off switch (i.e. "controls for initiating and terminating light transmission" and "circuitry in electrical connection with said controls" as required by claim 17. The use, however, of a conventional on/off switch to turn the device on and off when being used would have most certainly been obvious to the ordinarily skilled artisan.

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (WO 99/16136) in view of Prinsze (US 4,092,580).

Mills discloses a dental curing light (page 1, second paragraph) comprised of a hand held wand (Figure 5) having a light module 47, an elongated heat sink 45, 50, 51, a mounting platform 48 and light emitting semiconductor device 43 mounted on the mounting platform 48. Mills discloses that the device operates on DC power from batteries 52 and that the power supply may be rechargeable (see last paragraph of page 13), but doesn't expressly provide for the wall outlet power adapter for converting AC power to DC power as required by the claims. Wall outlet AC to DC adapters for recharging light batteries is old and well known as taught for example by Pinsze who uses wall AC to DC adapter 37 for charging light batteries 84, 85, 86. To have used such conventional prior art means as that suggest by Pinsze for recharging the Mills batteries in light of the Mills suggestion that the battery power source may be recharged

would have been obvious to one of ordinary skill in the art. Additionally Mills does not expressly state how the LEDs 43 are connected to platform 48, however, the use of a conventional prior art adhesives would have been obvious to one of ordinary skill in the art, it further noted that all adhesives have at least some degree of heat conductivity and light reflectivity.

Claims 12-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (WO 99/16136) in view of Prinsze (US 4,092,580) as applied above and in further view of Doiron et al (5,698,866).

In Mills the LEDs are mounted directly on a flat heat well 48. Doiron et al, however, teach that an improvement over mounting diodes on a flat surface (Figures 9 and 10) is mounting them in a well (Figures 11 and 12) so that more light from the LEDs is reflected forward in the desired direction. To have mounted the Mills LEDs in wells as taught by Doiron et al so that more light is reflected forward in the desired direction would have been obvious to one of ordinary skill in the art.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (WO 99/16136) in view of Doiron et al (5,698,866).

In Mills the LEDs are mounted directly on a flat heat sink 48. Doiron et al, however, teach that an improvement over mounting diodes on a flat surface (Figures 9 and 10) is mounting them in a well (Figures 11 and 12) formed on the heat sink so that more light from the LEDs is reflected forward in the desired direction. To have mounted

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the Mills LEDs in wells as taught by Doiron et al so that more light is reflected forward in the desired direction would have been obvious to one of ordinary skill in the art.

Allowable Subject Matter

Claims 5, 6 10 and 11 would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend and the obvious-type double patenting rejections overcome.


Prior Art

Applicant's information disclosure statement of March 21, 2002 has been considered an initialed copy enclosed herewith.

Adam et al (6,419,483 B1), Boutoussov et al (US 6,439,888 B1) , Fregoso (US 6,611,110 B1), Bianchetti et al (EP 1 090 607 A1) and Reipur (WO 02/33312 A2) are made of record.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(703) 308-0770**. Fax (703) 872-9302. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis
September 17, 2003



Ralph A. Lewis
Primary Examiner
Au 3732